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8 UNITED STATES DISTRICT COURT  
9 SOUTHERN DISTRICT OF CALIFORNIA  
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11 SPIRALEDGE, INC.,

12 Plaintiff,

13 v.

14 SEA WORLD ENTERTAINMENT, INC., et al.,

15 Defendants.  
16  
17

Case No. 13cv296-BAS (BLM)

**ORDER GRANTING IN PART AND  
DENYING IN PART PLAINTIFF'S  
MOTION TO COMPEL PRODUCTION OF  
DOCUMENTS**

**REDACTED**

**[ECF NO. 68]**

18 Currently before the Court is Plaintiff's April 18, 2014 motion to compel production  
19 of documents [ECF No. 68 ("MTC")], Defendants' April 29, 2014 opposition to the motion  
20 [ECF No. 86 ("Oppo.")], and Plaintiff's May 5, 2014 reply [ECF No. 82 ("Reply")]. For the  
21 reasons set forth below, Plaintiff's motion to compel production of documents is **GRANTED**  
22 **IN PART AND DENIED IN PART.**

23 **FACTUAL AND PROCEDURAL BACKGROUND**

24 Plaintiff filed a complaint in this matter on February 5, 2013 [ECF No. 1] and an  
25 amended complaint on March 12, 2013 alleging trademark infringement, unfair competition  
26 in violation of the Lanham Act, and unfair competition in violation of Business and  
27 Professions Code Section 17200. ECF No. 9. Defendants filed an answer and counterclaim  
28 on March 12, 2013 [ECF No. 10] and Plaintiff filed an answer on April 5, 2013 [ECF No. 24].

1 Plaintiff filed a motion for preliminary injunction on April 17, 2013 [ECF No. 28] which was  
2 denied on July 9, 2013. ECF No. 58. The Court held a Case Management Conference on  
3 May 10, 2013 [ECF No. 43] and a Mandatory Settlement Conference on June 27, 2013 [ECF  
4 No. 57].

5 On April 14, 2014, counsel for both parties jointly contacted the Court regarding a  
6 discovery dispute brought by Plaintiff concerning Defendants' assertion of the attorney client  
7 privilege in response to some of Plaintiff's discovery requests. ECF No. 65. In response, the  
8 Court ordered Plaintiff to file its motion to compel on or before April 18, 2014, Defendants  
9 to file their opposition on or before April 29, 2014, and Plaintiff to file its reply, if any, on or  
10 before May 5, 2014. Id.

### 11 **LEGAL STANDARD**

12 The Federal Rules of Civil Procedure generally allow for broad discovery, authorizing  
13 parties to obtain discovery regarding "any nonprivileged matter that is relevant to any party's  
14 claim or defense . . . ." Federal Rule of Civil Procedure ("Fed. R. Civ. P.") 26(b)(1). Also,  
15 "[f]or good cause, the court may order discovery of any matter relevant to the subject matter  
16 involved in the action." Id. Relevant information for discovery purposes includes any  
17 information "reasonably calculated to lead to the discovery of admissible evidence," and need  
18 not be admissible at trial to be discoverable. Id. A party may request the production of any  
19 document within the scope of Rule 26(b). Fed. R. Civ. P. 34(a).

20 Federal Rule of Evidence ("Fed. R. Evid.") 502 generally governs waiver of the  
21 attorney-client privilege. Fed. R. Evid. 502 provides that attorney-client privilege and work  
22 product protection can be waived by disclosures made during a federal proceeding if: "(1)  
23 the waiver is intentional; (2) the disclosed and undisclosed communications or information  
24 concern the same subject matter; and (3) they ought in fairness be considered together."  
25 Fed. R. Evid. 502. This subject matter waiver, however, "is reserved for those unusual  
26 situations in which fairness requires a further disclosure of related, protected information,  
27 in order to prevent a selective and misleading presentation of evidence to the disadvantage  
28 of the adversary." Fed. R. Evid. 502 advisory committee's note. "Rule 502 serves the

1 following purposes: (1) resolving longstanding disputes about the effect of certain disclosures  
 2 of privileged information—specifically disputes involving inadvertent disclosure and subject  
 3 matter waiver and (2) respond to the widespread complaint that litigation costs necessary  
 4 to protect against waiver of privilege have become prohibitive due to the concern that any  
 5 disclosure will operate as a subject matter waiver of all protected communication.” RIPL  
 6 Corp. v. Google Inc., 2013 WL 6632040, \*3 (W.D. Wash. Dec. 17, 2013) (quoting  
 7 Great-West Life & Annuity Ins. Co. v. Am. Econ. Ins. Co., 2013 WL 5332410, \* 7 (D. Nev.  
 8 Sept. 23, 2013) (citing Fed. R. Evid. 502 Advisory Comm. Note, Rev. 11/28/2007)). The rule  
 9 “seeks to provide a predictable, uniform set of standards under which parties can determine  
 10 the consequences of a disclosure of [privileged information]. Parties ... need to know, for  
 11 example, that if they exchange privileged information pursuant to a confidentiality order, the  
 12 court's order will be enforceable.” Fed. R. Evid. 502 Advisory Comm. Note, Rev.  
 13 11/28/2007.

14 “When a party puts at issue legal advice it received, e.g., by way of an advice of  
 15 counsel defense, it waives the attorney-client privilege with respect to those  
 16 communications.” Oakley, Inc. v. Bugaboos Eyewear Corp., 2010 WL 4117223, \*2 (S.D. Cal.  
 17 Oct. 15, 2010)(citing Chevron Corp. v. Pennzoil Co., 974 F.2d 1156, 1163 (9th Cir. 1992)).  
 18 A party cannot assert an advice of counsel defense, while protecting the communications  
 19 from disclosure. Id. “[S]elective waiver of the privilege may lead to the inequitable result  
 20 that the waiving party could waive its privilege for favorable advice while asserting its  
 21 privilege on unfavorable advice.” Id. (quoting In re EchoStar Commc’n Corp., 448 F.3d  
 22 1294, 1301 (Fed. Cir. 2006)). “To prevent such abuses, ... when a party defends its actions  
 23 by disclosing an attorney-client communication, it waives the attorney-client privilege as to  
 24 all such communications regarding the same subject matter.” Id.

## 25 DISCUSSION

26 The instant discovery dispute concerns Defendants’ responses to Plaintiff’s requests  
 27 for production of documents (“RFP”) and their assertion of the advice of counsel defense.  
 28 MTC at 8-9. The parties agree that Defendants have waived the attorney-client privilege as

1 to "the advice of counsel regarding the decision to use the Aquatica name,"<sup>1</sup> but disagree as  
 2 to the full scope of that waiver. MTC at 9, 13; Steinberg Decl., Exh. 27. Plaintiff argues that  
 3 even in light of Defendants' definition of the waiver<sup>2</sup>, Defendants have not produced all of  
 4 the required documents. MTC at 13. In support, Plaintiff lists various categories of  
 5 communications<sup>3</sup> which it argues Defendants have already produced and which show "that  
 6 a wide range of issues and considerations were addressed in the legal advice that played a  
 7 role in [Defendants'] decision-making about the Aquatica name over the years, and the  
 8 merits of any potential litigation," and argues that most of the documents being improperly  
 9 withheld by Defendants relate to one or more of the exact same categories. Id. at 13-14.  
 10 Plaintiff's position is that since the withheld documents relate to the legal advice Defendants  
 11 received on the risk of using the Aquatica name, they are within the scope of Defendants'  
 12 intentional waiver. Id. at 15. Plaintiff asks that the Court grant its motion to compel  
 13 following *in camera* review. Id. at 18.

14 Defendants argue that Plaintiff's motion is "overreaching and without merit, and the  
 15 motion should be denied in its entirety." Oppo. at 6. Defendants contend that Plaintiff's  
 16 position that "an advice of counsel defense waived the attorney-client privilege as to all  
 17 communications before this suit was filed pertaining to the trademark at issue, Aquatica" is  
 18 incorrect and that only documents "with 'direct relevance of the advice of counsel itself need  
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20 <sup>1</sup>This is the language that Defendants used in their email to Plaintiff's counsel informing Plaintiff's  
 21 counsel that Defendants would be waiving the privilege with respect to the advice of counsel. See Declaration  
 of Stephen C. Steinberg ("Steinberg Decl."), Exh. 25.

22 <sup>2</sup>Plaintiff states that Defendants have waived the privilege as to anything "related to [their] decision  
 23 to use the Aquatica name and the evaluations regarding the likelihood of success in a dispute with [Plaintiff]."  
 MTC at 13.

24 <sup>3</sup>Those categories include: [REDACTED]  
 25 [REDACTED]  
 26 [REDACTED]  
 27 [REDACTED]  
 28 [REDACTED].

1 be disclosed.” Id. at 5 (quoting Chiron Corp. V. Genentech, Inc., 179 F. Supp. 2d 1182,  
 2 1186 (E.D. Cal. 2001)). Defendants contend that they produced all opinions of counsel  
 3 relating to Plaintiff’s accusations of willful infringement, but did not “produce every attorney-  
 4 client communication relating to its Aquatica waterpark.” Id. at 12. Defendants argue that  
 5 their waiver is limited to privileged correspondence directly related to the advice they  
 6 received which was:

7 [REDACTED]  
 8 [REDACTED]  
 9 [REDACTED]  
 10 [REDACTED]  
 11 [REDACTED]  
 12 [REDACTED]

12 Id. at 14-15 (internal citations omitted). Based upon the scope of their waiver, Defendants  
 13 produced the following documents:

14 all attorney-client communications relating to the validity of the AQUATICA  
 15 mark, the likelihood of confusion between the parties’ uses of the mark,  
 16 [Defendants’] likelihood of success in either USPTO proceedings or a judicial  
 17 infringement action, and the reasonableness of [Defendants’] reliance upon  
 18 [their] counsel’s opinions.

19 Id. at 15. Defendants contend that they have properly withheld documents relating to their  
 20 (1) trademark applications, (2) litigation strategy, (3) strategy in Plaintiff’s opposition  
 21 proceeding, (4) unrelated attorney opinions, and (5) settlement communications. Id. at 19-  
 22 22. Defendants argue that contrary to Plaintiff’s arguments, they have not waived the  
 23 privilege as to every subject that was tangential to the advice they received or that was  
 24 contained in the opinions letter they produced and that the work product that was created  
 25 by their attorneys and never provided to Defendants does not have to be produced. Id. at  
 26 23-26. Finally, Defendants state that *in camera* review will demonstrate that Defendants  
 27 have not used the attorney-client privilege as a “sword and a shield.” Id. at 17.

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**A. Communications on Settlement, Negotiating, and/or Acquisition**

On February 25, 2014, Defendants asserted the advice of counsel defense and acknowledged that they were waiving the privilege as to “the advice of counsel regarding the decision to use the name Aquatica.” Steinberg Decl., Exh. 25. It is undisputed that Defendants then produced a number of privileged communications that contained the relevant advice of counsel. However, the vast majority of the documents that Defendants produced were unredacted<sup>4</sup> and they contained information on a variety of subjects, including subjects that were beyond the scope of the intended waiver. Steinberg Decl., Exhs. Plaintiff argues that this production of unredacted documents constitutes a subject matter waiver of the privilege as to all subjects discussed in the documents. MTC at 11-12; Reply 2-3. Defendants counter that they have not waived the privilege as to the additional subjects because they only produced the documents in an unredacted format in order to prevent discovery disputes over the extent of the redactions.<sup>5</sup> Opp. at 23-24.

Under Fed. R. Evid. 502, a party waives the attorney-client privilege and work product protection by disclosing communications during a federal proceeding if “(1) the waiver is intentional; (2) the disclosed and undisclosed communications or information concern the same subject matter; and (3) they ought in fairness be considered together.” Fed. R. Evid. 502. In this case, it is undisputed that Defendants intentionally produced the unredacted documents to Plaintiff and that the produced documents contain privileged communications about subjects Defendants claim are beyond the scope of their advice of

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<sup>4</sup>Plaintiff attached at least some of the produced documents to the declaration in support of its motion to compel and all but one document was unredacted. Steinberg Decl., Exh. 16.

<sup>5</sup>In support, Defendants cite Intex Recreation Corp. v. Metalast, S.A., 2005 WL 5099032, \*5 (D. D.C. March 2, 20015) which stated that “the fortuity of combining opinions or subjects in one letter should not result in a waiver of privilege as to unrelated subject matters” and found that the defendant was only required to produce settlement material that “contradicts or casts doubt on the earlier opinion letters.” Opp. at 23 (quoting Intex, 2005 WL 5099032 at \*5). While the Court agrees that the privilege as to unrelated subject matters should not be waived merely because the matters appear in an opinion letter produced in support of an advice of counsel defense, the instant dispute differs from Intex in that the opinion letter that was produced by the defendant in Intex redacted all information that did not relate to the patent at issue so the privilege for that material was never waived. See Intex, 2005 WL 5099032 at \*6. In contrast, Defendants in this case did not redact or otherwise attempt to continue to protect the information contained in the documents.

1 counsel waiver. Defendants have not presented any evidence indicating that the disclosure  
2 was unintentional, that they made any effort to prevent or limit the disclosure, or that they  
3 advised Plaintiff that while they were not redacting the documents, they only intended to  
4 waive the privilege as to certain specified portions of the documents. Moreover, the  
5 Protective Order agreed upon by the parties and entered by the Court merely addresses  
6 inadvertent disclosures and potential e-discovery productions. See ECF Nos. 33 at 13 and  
7 40. Accordingly, Defendants have waived the privilege as to all communications disclosed  
8 in the produced documents and the first element is satisfied. Fed. R. Evid. 502. The  
9 second element also is satisfied as the parties agree that there are unproduced privileged  
10 documents that concern the same subjects that were contained in the initial intentional  
11 unredacted production. *Oppo*. at 23. The Court's focus therefore is on the third element -  
12 whether in fairness the undisclosed communications should be considered with the disclosed  
13 communications.

14 The advisory notes to Fed. R. Evid. 502 instruct that

15 a voluntary disclosure in a federal proceeding ... generally results in a waiver  
16 only of the communication or information disclosed; a subject matter waiver  
17 (of either privilege or work product) is reserved for those unusual situations  
18 in which fairness requires a further disclosure of related, protected  
19 information, in order to prevent a selective and misleading presentation of  
evidence to the disadvantage of the adversary. [citation omitted] Thus,  
subject matter waiver is limited to situations in which a party intentionally  
puts protected information into the litigation in a selective, misleading and  
unfair manner.

20 Fed. R. Evid. 502 advisory committee's note. Plaintiff argues that "fairness dictates that the  
21 withheld documents must be disclosed" because Defendants intend to rely on their  
22 "selectively produced attorney-client privileged documents to establish its good faith belief  
23 that it could validly use the Aquatica mark in the face of mounting facts to the contrary" and  
24 because Defendants have "selectively disclosed various attorney-client communications that  
25 suggest that early in time . . . it was reasonable for SeaWorld to broadly pursue use of the  
26 Aquatica mark because of the opinions of its legal counsel. However, [Defendants have]  
27 blocked [Plaintiff's] ability to challenge the inferences raised by the disclosed attorney-client  
28

1 communications because [Defendants] continue[] to withhold the majority of related  
2 communications, particularly those from after 2008." MTC at 17.

3 Defendants do not address their intentional waiver under Fed. R. Evid. 502 and  
4 instead insist that they have "properly maintained the privilege as to [the unproduced]  
5 documents." Oppo. at 12. Defendants do, however, contend that maintaining the privilege  
6 of the unproduced documents would not be unfair to Plaintiff because the withheld  
7 documents regarding settlement and the opposition proceedings are not "directly relevant"  
8 to the opinions relied upon by Defendants and "do not reflect any attorney opinions  
9 concerning the merits of the case or [Defendants'] likelihood of success before the USPTO  
10 or an infringement action." Id. at 22. Defendants further contend that "tangential issues  
11 raised in the opinion letters do[] not broaden the scope of the waiver to include all such  
12 issues" and that Plaintiff's request for all confidential information about discussions  
13 Defendants had about negotiations or potentially purchasing Plaintiff's ITU application and  
14 domain name simply because Defendants provided Plaintiff with some of this information  
15 "in the same communications in which they provided their substantive analysis on the  
16 merits" is improper. Id. at 22-23.

17 The Court finds that while Defendants have waived the attorney-client privilege for  
18 all information contained in the documents already produced, this is not the unusual  
19 situation where "fairness requires a further disclosure of related, protected information, in  
20 order to prevent a selective and misleading presentation of evidence to the disadvantage  
21 of [Plaintiff]." Fed. R. Evid. 502. Here, Defendants have produced

22 all attorney-client communications relating to the validity of the AQUATICA  
23 mark, the likelihood of confusion between the parties' uses of the mark,  
24 [Defendants'] likelihood of success in either USPTO proceedings or a judicial  
infringement action, and the reasonableness of [Defendants'] reliance upon  
[their] counsel's opinions.

25 Id. at 15. Therefore, any settlement communications or negotiations that relate to the  
26 validity of the mark, likelihood of confusion, likelihood of success, or the reasonableness of  
27 the Defendants' reliance on the advice of counsel have been (or should be) produced. Any  
28 other settlement communications or negotiations, such as when to make a settlement offer



1 to Plaintiff or whether to try to acquire Plaintiff, are irrelevant (unless they incorporate or  
 2 rely on an analysis of the validity of the mark, likelihood of confusion or success, or  
 3 reasonableness of the reliance). Plaintiff has not presented any information indicating that  
 4 Defendants are using or intend to use the irrelevant settlement or negotiation  
 5 communications in any way to support their advice of counsel defense. Similarly,  
 6 Defendants have indicated that these topics are irrelevant to their defense.<sup>6</sup> *Id.* at 21-23.  
 7 As such, there is no evidence indicating that Defendants are intentionally putting "protected  
 8 information into the litigation in a selective, misleading and unfair manner" [Fed. R. Evid.  
 9 502] and the Court has no reason to believe that is the case. Accordingly, Plaintiff's motion  
 10 to compel all additional privileged communications regarding settlement, negotiation and  
 11 acquiring Plaintiff is **DENIED**.

#### 12 **B. Communications Regarding Defendants' Trademark Applications and** 13 **Strategy in Plaintiff's Opposition Proceedings**

14 Plaintiff argues that Defendants should be required to produce all communications  
 15 on this subject because they relate to communications that Defendants have already  
 16 produced and because Defendants' "communications with its attorneys related to its  
 17 trademark applications, the opposition proceedings, the PTO's rejections, and [Defendants']  
 18 responses to those rejections, necessarily relate to [their] reliance on the advice of [their]  
 19 counsel about the likelihood of confusion." MTC at 14-15; Reply at 3-4.

20 Defendants object to Plaintiff's broad request and reiterate that their waiver only  
 21 extends to the scope of the advice of counsel; it does not encompass all documents  
 22 concerning its applications to register its trademarks. *Oppo.* at 18-20. As previously stated,  
 23 Defendants' waiver extends to "the advice of counsel regarding the decision to use the  
 24 name Aquatica" and "all attorney-client communications relating to the validity of the  
 25 AQUATICA mark, the likelihood of confusion between the parties' uses of the mark,

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27  
 28 <sup>6</sup>If the Court is incorrect and Defendants attempt to rely on these communications or the challenged  
 subject matters to prove any issue or defense, the Court **RECOMMENDS** that Defendants' efforts be **DENIED**.

1 [Defendants'] likelihood of success in either USPTO proceedings or a judicial infringement  
2 action, and the reasonableness of [Defendants'] reliance upon [their] counsel's opinions"  
3 and Defendants claim they have produced all such documents. Steinberg Decl, Exh. 25.;  
4 Oppo. at 15. Defendants object to the production of any additional communications  
5 regarding its trademark applications.

6 As set forth in Section A. above, the Court finds that Defendants' intentional  
7 production of unredacted documents has not created a subject matter waiver as to all  
8 subjects discussed in the produced documents and therefore Defendants do not have to  
9 produce all privileged communications regarding trademark applications and strategy in the  
10 opposition proceedings merely because the subjects were discussed in the unredacted  
11 documents produced by Defendants. Plaintiff's alternative argument is that Defendants  
12 must produce all documents related to its trademark applications because the PTO found  
13 a likelihood of confusion and therefore the documents must "necessarily relate to its reliance  
14 on the advice of counsel about the likelihood of confusion." Reply at 3-4.

15 The Court disagrees with Plaintiff's assumption. The Court finds that it is possible  
16 that there are communications regarding Defendants' trademark applications and its  
17 strategy in Plaintiff's opposition proceedings that do not touch upon advice or opinions from  
18 Defendants' counsel regarding the decision to use the name Aquatica, and/or the likelihood  
19 of confusion, likelihood of success, and reasonableness of the reliance, and which therefore  
20 are beyond the scope of Defendants' waiver. For example, an attorney-client  
21 communication relating to litigation strategy in the PTO, such as the timing of discovery  
22 requests, would not be encompassed by the advice of counsel waiver in this case. Such  
23 communications are irrelevant and beyond the scope of the waiver and need not be  
24 produced. However, if a communication relates to "the validity of the AQUATICA mark, the  
25 likelihood of confusion between the parties' uses of the mark, [Defendants'] likelihood of  
26 success in either USPTO proceedings or a judicial infringement action, and the  
27 reasonableness of [Defendants'] reliance upon [their] counsel's opinions," it must be  
28 produced to Plaintiff.

1 Accordingly, Plaintiff's motion to compel communications that fall into this category  
2 is **GRANTED IN PART AND DENIED IN PART**. Defendants are required to produce all  
3 additional privileged communications regarding its trademark applications and strategy in  
4 Plaintiff's opposition proceedings that relate to the validity of the AQUATICA mark, the  
5 likelihood of confusion between the parties' uses of the mark, Defendants' likelihood of  
6 success in either USPTO proceedings or a judicial infringement action, and the  
7 reasonableness of Defendants' reliance upon their counsel's opinions. Communications  
8 concerning Defendants' strategy for their trademark applications and action in the  
9 opposition proceedings which do not touch upon advice or opinions received from counsel  
10 about the mark, need not be produced or may be redacted as necessary if combined with  
11 relevant opinions or advice. At this time, the Court declines to perform an *in camera* review  
12 of the documents that have been lodged as the Court is confident that counsel can comply  
13 with the Court's order.

14 **C. Communications Containing Unrelated Attorney Opinions**

15 Defendants state that they have withheld documents that "contain attorney opinions  
16 regarding foreign trademarks and [Defendants'] use of the AQUATICA mark outside the  
17 United States, and which do not speak to the opinions at issue here." Oppo. at 22. Plaintiff  
18 does not appear to claim that Defendants have waived any privilege regarding this subject  
19 through their production. See MTC; Reply. In addition, the Court does not find that  
20 fairness requires Defendants to produce this information to Plaintiff as Defendants have  
21 asserted the advice of counsel defense in response to Plaintiff's allegations in the instant  
22 matter which does not concern foreign use of the AQUATICA mark. Accordingly, the Court  
23 finds that Defendants' waiver does not extend to communications regarding attorney  
24 opinions concerning foreign trademarks and Defendants' use of the AQUATICA mark in  
25 foreign countries. These communications fall outside of the scope of the waiver and  
26 Defendants are not relying on the opinions contained in these communications in the instant  
27 matter. Accordingly, Plaintiff's motion to compel any documents that fall into this category  
28 is **DENIED**.

**D. Attorney Work Product Never Communicated to Defendants**

Defendants rely on In re EchoStar Commc'n Corp., 448 F.3d at 1303 for their position that the waiver does not extend to attorney work product that was never communicated to Defendants. Oppo. at 25. Plaintiff agrees that EchoStar applies, but argues that if any of the communications that were not provided to Defendants "describe or reference communications with [Defendants], then they must be produce." Reply at 6 (citing In re EchoStar Commc'n Corp., 448 F.3d at 1302-1304). EchoStar recognized three categories of attorney work product relevant to the advice of counsel defense. In re EchoStar Commc'n Corp., 448 F.3d at 1302. The categories include

(1) documents that embody a communication between the attorney and client concerning the subject matter of the case, such as a traditional opinion letter; (2) documents analyzing the law, facts, trial strategy, and so forth that reflect the attorney's mental impressions but were not given to the client; and (3) documents that discuss a communication between attorney and client concerning the subject matter of the case but are not themselves communications to or from the client.

Id. (citing Thorn EMI N. Am. v. Micron Tech., 837 F. Supp. 616, 622-623 (D. Del. 1993)). The court in EchoStar found that when a party asserts the advice of counsel defense in response to a claim of willful infringement, it waives its attorney-client privilege for the first and third category of documents, but not the second category of documents. Id. at 1302-1303. The court found that the second category of documents "deserve[d] the highest protection from disclosure" under Fed. R. Civ. P. 26(b)(3) and "provides little if any assistance to the court in determining whether the accused knew it was infringing." Id. at 1303-1304.

The Court finds that the conclusion in EchoStar is equally applicable to the instant matter and that work product that was not communicated to Defendants need not be produced unless the work product describes or summarizes a communication between an attorney and Defendants on the relevant topics. Accordingly, Plaintiff's motion to compel any documents that fall into this category is **GRANTED IN PART AND DENIED IN PART**. Defendants must produce any "documents that discuss a communication between attorney and client concerning the subject matter of the case but are not themselves communications

1 to or from the client.” In re EchoStar Commc’n Corp., 448 F.3d at 1302. If the  
 2 communications contain work product described in the second category of documents,  
 3 Defendants may redact the documents as necessary. Id. at 1304. Defendants need not  
 4 produce any other uncommunicated work product. At this time, the Court declines to  
 5 conduct an *in camera* review of the documents as the Court has no reason to believe that  
 6 Defendants cannot comply with the Court’s Order and produce the required  
 7 communications. All responsive communications must be produced by **June 27, 2014.**

#### 8 **E. Communications Regarding Litigation Strategy**

9 Plaintiff contends that Defendants are improperly withholding privileged documents  
 10 involving attorney Andrea Anderson. Reply at 4-5. Plaintiff argues that Defendants have  
 11 waived the privilege as to communications involving Ms. Anderson by intentionally producing  
 12 privileged communications involving this attorney and because she is not part of the trial  
 13 team. Id. Defendants contend that the communications identified on their privilege log are  
 14 between Ms. Anderson, “one of [Defendants’] outside trademark attorneys,” and their  
 15 current trial counsel and contain “purely strategic discussions about the instant litigation”  
 16 which “plainly fall outside the scope of the waiver.” *Oppo.* at 20.

17 Initially, to the extent Plaintiff’s claim is premised on the argument that Defendants’  
 18 unredacted document production constituted a subject matter waiver requiring the  
 19 production of all privileged communications on the same subjects, including communications  
 20 involving Ms. Anderson, Plaintiff’s request is denied. As set forth in Section A. above, the  
 21 Court has found that there was not a subject matter waiver under Rule 502 as to the  
 22 additional subjects discussed in the unredacted documents produced to Plaintiff. The Court  
 23 therefore will address only Plaintiff’s argument that the privileged communications must be  
 24 produced because Ms. Anderson is not part of the trial team.

25 As the parties state, there is a split of authority regarding whether a defendant’s  
 26 privilege waiver based upon an advice of counsel defense extends to communications with  
 27 trial counsel. Several courts have held that an advice of counsel defense waiver does not  
 28 encompass communications involving trial counsel. See In re Seagate Technology, LLC, 497

1 F.3d 1360, 1374 (Fed. Cir. 2007) (holding "as a general proposition, that asserting the  
 2 advice of counsel defense and disclosing opinions of opinion counsel do not constitute  
 3 waiver of the attorney-client privilege for communications with trial counsel"); see also  
 4 Collaboration Properties, Inc. v. Ploycom, Inc., 224 F.R.D. 473, 476-477 (N.D. Cal. 2004)  
 5 (stating that waiver did not extend to litigation-related communications with litigation  
 6 counsel after the complaint was filed). Other courts have chosen a middle ground between  
 7 declaring all communications with trial counsel privileged and extending the waiver to all  
 8 communications with trial counsel. See Genentech, Inc. v. Insmed Incorporation, 442 F.  
 9 Supp. 2d 838, 847 (N.D. Cal. 2006) (adopting a middle ground approach and giving Plaintiff  
 10 access to "opinion type" communications with trial counsel) (citing Intex Recreation Corp.  
 11 v. Metalast, S.A., 400 F. Supp. 2d 123 (D.D.C.2005); Beneficial Franchise Co. v. Bank One,  
 12 N.A., 205 F.R.D. 212 (N.D. Ill. 2001); BASF Aktiengesellschaft v. Reilly Indus., Inc., 283 F.  
 13 Supp. 2d 1000 (S.D. Ind. 2003); and Micron Separations, Inc. v. Pall Corp., 159 F.R.D. 361  
 14 (D. Mass. 1995) as generally finding waiver "appropriate to the extent the advice or work  
 15 product of trial counsel was communicated to the client" and "contained conclusions or  
 16 advice that contradict or cast doubt on the earlier opinions").

17 The question is more difficult when, as here, the communications at issue take place  
 18 between opinion counsel and trial counsel. Courts have found that waiver should extend  
 19 to communications between opinion counsel and trial counsel where trial and opinion  
 20 counsel were from the same firm or office or where the communications concern the  
 21 opinions that are the basis for the advice of counsel defense being asserted. See Terra  
 22 Novo, Inc. v. Golden Gate Products, Inc., 2004 WL 2254559, \*3 (N.D.Cal., 2004) (finding  
 23 that defendant waived the attorney-client privilege for all communications between  
 24 Litigation Counsel and Opinion Counsel relating to invalidity of the patent in suit); see also  
 25 Informatica Corp. v. Business Objects Data Integration, Inc., 454 F. Supp. 2d 957, 964 (N.D.  
 26 Cal., 2006) (finding the privilege waived for all relevant communications and work product  
 27 of all counsel and noting that "[w]hile opinion counsel and trial counsel can be walled off  
 28 from each other, the immurement is immaterial - what matters, according to the decision

1 by the Federal Circuit in EchoStar, is the state of mind of [defendant]"); and Celerity, Inc.  
 2 v. Ultra Clean Holding, Inc., 476 F. Supp. 2d 1159, 1164 (N.D. Cal. 2007) (noting that the  
 3 court has previously ruled "where opinion counsel and trial counsel are in the same firm,  
 4 the same shelter does not extend for communications between a client and trial counsel,  
 5 if they are on the subject of the opinion relied on) (emphasis in original).

6 Contrary to Plaintiff's argument, the Court believes that Defendants are not claiming  
 7 privilege because Ms. Anderson is part of the trial team or because she was communicating  
 8 with trial counsel. Rather, Defendants are claiming privilege as to many of Ms. Anderson's  
 9 communications or notes because the communications or notes themselves are not relevant  
 10 to the advice of counsel defense asserted in this case and the resulting waiver. See Oppo.  
 11 at 20 (communications between Ms. Anderson and current trial counsel were withheld  
 12 because they involve "purely strategic discussions about the instant litigation ... [and] plainly  
 13 fall outside the scope of the waiver").

14 The Court concludes that Ms. Anderson's communications are not outside the scope  
 15 of the waiver merely because they occurred between Ms. Anderson and trial counsel. The  
 16 Court further finds that her communications and notes are outside the scope of the waiver  
 17 if they only relate to litigation strategy. If, however, there are conversations between Ms.  
 18 Anderson and trial counsel (or notes regarding such communications) that concern the  
 19 validity of the AQUATICA mark, the likelihood of confusion between the parties' uses of the  
 20 mark, the likelihood of success in either PTO proceedings or a judicial infringement action,  
 21 or the reasonableness of Defendants' reliance on counsel's opinions, those communications  
 22 are encompassed by the advice of counsel waiver and they must be produced. Accordingly,  
 23 Plaintiff's motion to compel communications that fall into this category is **GRANTED IN**  
 24 **PART AND DENIED IN PART**. Defendants are required to produce all communications  
 25 between its trial counsel and opinion counsel, including Ms. Anderson, regardless of when  
 26 the communications occurred, which concern the advice of counsel regarding the decision  
 27 to use the name Aquatica. If the communications only contain litigation strategy and do not  
 28 discuss opinions related to the advice of counsel defense that Defendants have raised, they

1 need not be produced.

2 **CONCLUSION**

3 1. Plaintiff's motion to compel communications regarding settlement, negotiation  
4 and acquiring Plaintiff is **DENIED**.

5 2. Plaintiff's motion to compel communications regarding Defendants' trademark  
6 applications and strategy in Plaintiff's opposition is **GRANTED IN PART AND DENIED IN**  
7 **PART**. Defendants are required to produce the required communications or before **June**  
8 **27, 2014**.

9 3. Plaintiff's motion to compel any documents that "contain attorney opinions  
10 regarding foreign trademarks and [Defendants'] use of the AQUATICA mark outside the  
11 United States" is **DENIED**.

12 4. Plaintiff's motion to compel attorney work product that was never  
13 communicated to Defendants is **GRANTED IN PART AND DENIED IN PART**.  
14 Defendants must produce the required communications on or before **June 27, 2014**.

15 5. Plaintiff's motion to compel communications between Defendants' trial counsel  
16 and opinion counsel is **GRANTED IN PART AND DENIED IN PART**. Defendants are  
17 required to produce the required communications on or before **June 27, 2014**.

18 **IT IS SO ORDERED.**

19  
20 DATED: June 18, 2014

21 

22 BARBARA L. MAJOR  
23 United States Magistrate Judge  
24  
25  
26  
27  
28